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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,105	09/17/2003	John Andrew Gladysz	030557	4775
26285	7590	07/17/2006	EXAMINER	
KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP 535 SMITHFIELD STREET PITTSBURGH, PA 15222			PUTTLITZ, KARL J	
			ART UNIT	PAPER NUMBER
			1621	
DATE MAILED: 07/17/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/664,105

Applicant(s)

GLADYSZ ET AL.

Examiner

Karl J. Puttlitz

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-70 is/are allowed.
- 6) ☒ Claim(s) 1-10, 13, 15-19, 22-29, 34-36 and 40-42 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 14, 20, 21, 30-33, 37-39, 43 and 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/17/2006 has been entered.

The rejection under section 112, first paragraph is withdrawn in view of the Declaration dated 3/17/2006 which shows, via literature in the art, that the claimed method can be used with other processes than hydroalkoxation and hydrosilation without undue experimentation.

The following is a new ground of rejection:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-10, 13, 15-19, 22-29, 34-36 and 40-42 are rejected under 35 U.S.C. 102(a) as being anticipated by Wende et al., Journal of the American Chemical Society, 2001, 123, 1 1490-11491 (Wende).

The rejected claims are drawn to, inter alia, a method for conducting a chemical reaction in a non-fluorous medium using a fluorous compound in the presence of a solid adsorbant containing a fluorous domain and at least one chemical reactant, the method comprising: contacting the fluorous compound and the at least one chemical reactant under conditions that form at least one product.

As admitted in the Declaration under 37 CFR 1.132, the JACS Article describes the method for conducting chemical reactions using fluorous catalysis without fluorous solvents based upon thermomorphic properties and liquid/solid phase separation. The JACS Article describes a method for conducting the reactions in the presence of a solid adsorbant (i.e., Teflon beads or shavings) (see, page 11491, first column, first full paragraph). See Declaration at pages 3 and 4. The articles also describes recycle of a fluopro-catalyst (i.e., a fluorous compound) by way of such methods as decreasing temperature and extraction (see claim 9, "adjusting a solvent concentration").

The foregoing anticipates the rejected claims.

Claims 11, 12, 14, 20, 21, 30-33, 37-39, 43 and 44 are objected to for dependence on one or more rejected claims. These claims would be allowable if rewritten to include all limitation intervening claims.

Claims 45-70 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at telephone number (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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